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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,603	02/19/2004	Robert E. Grove	2502187-991200	1625

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EXAMINER	
SHAY, DAVID M	

ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/783,603	GROVE ET AL.	
	Examiner	Art Unit	
	david shay	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-78* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-78* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 71-78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 71 requires "(d) transmitting the light pulse... [to] an operative through which eye safe light pulse are propagated having an output fluence not less than 4 J/cm^{2}" and "(e) optically diffusing the light pulse along the light path so that an integrated radiance of the output light pulse is reduced to an eye safe value." Thus (e) requires the diffusing along the light path, which is prior to the aperture reducing the integrated radiance to an eye safe value. This eye-safe valve is described at e.g. page 9, lines 14-24 of the originally filed disclosure as being equal to 1.8 x 10^{-3} $t^{0.75}$ C_4C_6. However, using the maximum disclosed valves for all the variables (t =1sec; C4=5; and C6=66.7) yields a maximum output of 0.6003 J/cm^2. Thus claims 71-77 are indefinite as they simultaneously require the output pulses to be greater than 4.0 and less than 0.6 J/cm^2. Art cannot be meaningfully applied to these claims. Claims 3 and 15 are indefinite due to use of the trademark SPECTRALON.

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5, 8, 16-18, 20-34, and 36-44 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Grove et al ('901).

See Figures 1 and 2 and column 1, line 30 to column 3, line 20; column 4, line 11-22; and column 5, line 66 to column 7, line 37. Wherein the device is "configured" for the various

treatments, since it can apply light to the various tissues desired to be treated and the device "has a fluence at the eye of a person less than a maximum permissible exposure..." for people more than a mile away from the device.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

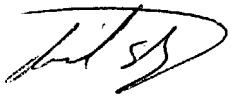
> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 45-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grove et al ('901) in combination with Grove et al ('403). Grove et al ('901) teach a device such as claimed, as set forth above, but does not teach a pulse repetition rate or a reflective diffusion. Grove et al ('403) teach the desirability of using pulse rate in the claimed range. It would have been obvious to the artisan of ordinary skill to employ the pulse rate of Grove et al ('403) in the device of Grove et al ('901) since this provides beneficial medical treatments as taught by Grove et al ('403) and to employ a reflective diffuser rather than the diffractive diffuser of Grove et al ('901) since there are notorious equivalents in the art, official notice of which is hereby taken, and provide no unexpected results, thus producing device such as claimed.

Claims 3, 4, and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grove et al ('903) in combination with Rosow et al. Grove et al (903) provide the teaching set forth above. Rosow et al teach the use of opal glass as a diffuser. It would have been obvious to the artisan of ordinary skill to employ opal glass as taught by Rosow et al in the device of Grove et al (903), since this would help provide more uniform illumination and would be easier to fabricate than a precision lenslet array, this producing a device such as claimed.

Claims 6, 7, 9, 10, 19, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grove et al (903) in view of McDaniel. Grove et al provide the teaching set forth above. McDaniel teaches the use of a holographic diffuser and the equivalence of LEDs and flashlamps. It would have been obvious to the artisan skill to employ a flashlamp in the device of Grove et al (903) since these are equivalents, as taught by McDaniel, and to employ a holographic diffuser, since this would provide more evenly distributed light, or to employ the parameters of Grove et al (903) in the device of McDaniel, since the device of McDaniel intends to provide a variety of treatment and in either case to employ a Fresnel type diffuser since this is a notorious diffuser configuration, official notice of which is hereby taken, thus producing a device such as claimed.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.



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